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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,939	03/28/2001	Steven Mentzer	7032/1002	2967

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LEROUX, ETIENNE PIERRE

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2171

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DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/819,939	MENTZER, STEVEN
	Examiner Etienne P LeRoux	Art Unit 2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 March 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5</u> . | 6) <input type="checkbox"/> Other: _____ |

Specification Objection

1. The incorporation of essential material in the specification, page 52, line 5 through page 58, by reference to a foreign application or patent, or to a publication is improper.

Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

2. Background of the Invention:

See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

3. Reference to Copending Application:

It is noted that this application appears to claim subject matter disclosed in prior Application No. 60/193,353, filed March 28, 2000. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR

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1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5, 9, 13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No. 5,196,510 issued to Rodwell et al (hereafter Rodwell '510).

Regarding claims 1, 5, 9, 13 and 17, Rodwell '510 discloses:

a web site containing a database of monospecific probe properties / monoclonal antibodies¹ and connected to users through a computer network to allow users to enter criteria for retrieving monospecific probe / monoclonal antibodies properties

wherein the web site produces a list of matching information on monospecific probes / monoclonal antibodies matching the selection criteria and displays the matching information on monospecific probes / monoclonal antibodies on the list in an order determined by each probe's similarity to the selection criteria [col 13, line 48 through column 14, line 14].

¹ Refer instant specification which teaches monoclonal antibodies are an example of monospecific probes

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodwell '510 as applied to claims 1, 9 and 13 above, and further in view of US Pat No. 4,741,043 issued to Bacus (hereafter Bacus '043).

Regarding claims 2, 6, 10 and 14, Rodwell '510 discloses the essential elements of the claimed invention except for monospecific probe histograms. Bacus '043 discloses monospecific histograms [Fig 9]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rodwell '510 to include monospecific histograms as taught by Bacus '043 for the purpose of displaying cell DNA content [col 8, line 1]

5. Claims 3, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rodwell '510 and Bacus '043 as applied to claims 2, 9 and 13 above, and further in view of US Pat No. 5,487,112 issued to Zygourakis et al (hereafter Zygourakis '112).

Regarding claims 3, 11 and 15, the combination of Rodwell '510 and Bacus '043 discloses the essential elements of the claimed invention except for kernel smoothing. Zygourakis '112 discloses kernel smoothing [col 4, lines 18-32]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of

Rodwell '510 and Bacus '043 as taught by Zygourakis '112 for the purpose of providing a calibration routine [col 4, line 10].

6. Claims 4, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodwell '510 as applied to claims 1, 9 and 13 above, and further in view of US Pat No. 4,870,568 issued to Kahle et al (hereafter Kahle '568).

Regarding claims 4, 12, and 16, Rodwell '510 discloses the essential elements of the claimed invention except for relevance feedback. Kahle '568 discloses relevance feedback [col 2, line 60 through col 3, line 15]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rodwell '510 to include relevance feedback as taught by Kahle '568 for the purpose of formulating a search strategy [col 2, lines 55-61].

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rodwell '510 as applied to claim 5 above, and further in view of Pub No US 2002/0015971 authored by Verwer (hereafter Verwer '591).

Regarding claim 7, Rodwell '510 discloses the essential elements of the claimed invention except for generating a histogram by means of a flow cytometer. Verwer '591 discloses generating a histogram by means of a flow cytometer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rodwell '510 to include generating a histogram by means of a flow cytometer as taught by Verwer '591 for the purpose of sorting the cells [paragraph 0029].

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8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rodwell '510 and Verwer '591 as applied to claims 5 and 7 above, and further in view of US Pat No. 5,487,112 issued to Zygourakis et al (hereafter Zygourakis '112).

Regarding claim 8, the combination of Rodwell '510 and Verwer '591 discloses the essential elements of the claimed invention except for kernel smoothing. Zygourakis '112 discloses kernel smoothing [col 4, lines 18-32]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Rodwell '510 and Verwer '591 as taught by Zygourakis '112 for the purpose of providing a calibration routine [col 4, line 10].

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Pub No US 2003/0028501 authored by Balaban et al discloses a computer system for managing laboratory operations for gene expression monitoring, sequencing and sequence checking.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahić, can be reached on (703) 308-1436.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux
June 13, 2003 


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100